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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

JACKSON, JAKIEDA R

ART UNIT

PAPER NUMBER

2626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/035,085	Applicant(s) SEME, YONAS D.	
	Examiner JAKIEDA R. JACKSON	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-42 and 48-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 37-42 and 48-58 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Appeal Brief

1. In response to the Office Action mailed May 7, 2008, Applicants filed an Appeal Brief filed on January 7, 2009. After reviewing the remarks, Applicant's arguments were persuasive. Prosecution will be reopened based on new grounds of rejections and the Office regrets any inconvenience.

Response to Arguments

2. Applicant argues that the prior art cited fails to teach a first device that transmits to a second device an indication of a first translation preference, receives from the second device an indication of a second translation preference and translates a message from the first translation preference to the second translation preference based on the received indication of the second translation preference. Applicant further argues that the prior art fails to disclose a first device that receives from a second device an indication of a second translation preference and translates a message from a first translation preference to the second translation preference based on the received indication of the second translation preference. Also, Applicant's argue that the prior art cited fails to disclose receiving geographic information and translating a message based on the received geographic information. Applicant's arguments are persuasive, but are moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 37-42 and 48-57** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin et al. (PGPUB 2001/0029455), hereinafter referenced as Chin in view of Stringham (PGPUB 2002/0188670).

Regarding **claims 37 and 48**, Chin discloses a method and system for translating instant messages exchanged (translated instant message) between a first user using a first device and a second user using a second device over a communication network (from one user to another), the first user having a first translation preference and the second user having a second translation preference (paragraphs 0108-0109), the method comprising:

establishing an instant messaging session between the first device and the second device (instant message; figure 43);

sending by the first device to the second device during the established session an indication of the first translation preference (name, language preference and message displayed; figure 43);

receiving by the first device from the second device an indication of the second translation preference (the message sent is displayed in both the source and target languages. Next to the persons name displays their language preference), wherein the second translation preference is different from the first (English/French; figure 43); and

during the initiated session,

receiving by the first device from the first user a first message intended for the second device, the first message composed according the first translation preference (figure 43)

based on the received indication of the second translation preference, translating the received first message from the first translation preference to the second translation preference (English spoken message is translated to French and vice versa); and

transmitting the translated message in the second translation preference to the second device as an instant message during the established session via the communication network (paragraphs 0017-0018), but does not specifically that the translation is done by the first device based on the received indication of the second translation preference.

Stringham discloses a method and system wherein the language translation may be performed using automated language translation software that is incorporated into the program (abstract with paragraph 0016) and on the device where the language used by the associated designated correspondent is retrieved (paragraph 0019), to enable a message translation.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Chin's method and system as described above, to enable language translation the allows the translation to be done by the device itself (paragraph 0006), as taught by Stringham.

Chin teaches, this information is helpful to allow translations to be more effective and thereby more easily understood and a higher translation quality (paragraph 0111-0113). If the preferred target language is known by the users, it can help make the language as clean and proper as possible (paragraph 0137). Further, it can show users who understand at least some of the target language the strengths and limitations of the system and helps educate them about the most productive use if the translation engine (paragraphs 0178-0189). It also provides a communal nature of the chat room to allow users to help each other to find the best language for translation, helps users determine the best phrasing in order to achieve high-quality translation and once the user knows what the target language is, and there needs to be changes made, the user can select the list for that language, which will provide the best language construction to user to produce the best translations (paragraphs 0222-0228).

Regarding **claims 38 and 49**, Chin discloses the method and system further comprising, storing by the first device the received indication of the second translation preference (stored profiles; paragraph 0261).

Regarding **claims 39 and 50**, Chin discloses the method and system wherein the translation preference is specified as a destination language (location/country of origin; paragraph 0261).

Regarding **claims 40 and 51**, Chin discloses an instant messaging method and system wherein the translation preference is specified as a locality (location; paragraph 0261).

Regarding **claims 41 and 52**, Chin discloses the method and system wherein the translation preference is specified as a geographic setting (location/origin; paragraph 0261).

Regarding **claim 42**, Chin computer-readable medium instructions for performing the steps recited in claim 37 (computer communication; paragraph 0005 and 0117).

Regarding **claim 53**, it is interpreted and rejected for the same reasons as set forth in claim 37 and 48. In addition, Chin discloses the profile information is based on geographic information (figure 1, flags represent country of origin with location; paragraph 0261). As Chin teaches, this information is helpful to allow translations to be more effective and thereby more easily understood and a higher translation quality (paragraph 0111-0113). If the preferred target language is known by the users, it can help make the language as clean and proper as possible (paragraph 0137). Further, it can show users who understand at least some of the target language the strengths and limitations of the system and helps educate them about the most productive use of the translation engine (paragraphs 0178-0189). It also provides a communal nature of the chat room to allow users to help each other to find the best language for translation, helps users determine the best phrasing in order to achieve high-quality translation and once the user knows what the target language is, and there needs to be changes made,

the user can select the list for that language, which will provide the best language construction to user to produce the best translations (paragraphs 0222-0228).

Regarding **claim 54**, Chin teaches a method the first geographic information includes a locality of the first user (figure 1 with paragraph 0261).

Regarding **claim 55**, Chin discloses a method wherein the computer system is the first device of the first user (computer; paragraphs 0005 and 0017-0018).

Regarding **claim 56**, Chin teaches a method wherein the computer system is a server (server; paragraphs 0110-0112).

Regarding **claim 57**, Chin discloses a method wherein the receiving of the first profile information (profile) and the receiving of the second message are performed at the second device and the receiving of the second profile information and the receiving of the first message are performed at the first device (paragraph 0117).

Regarding **claim 58**, Chin discloses a method wherein the receiving of the first profile information and the second profile information occurs during initiation of a session for exchanging messages (once user says hello, the profile information is transmitted also, figures 1 and 43).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAKIEDA R. JACKSON whose telephone number is (571)272-7619. The examiner can normally be reached on Monday-Friday from 5:30am-2:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R Hudspeth/
Supervisory Patent Examiner, Art Unit 2626

/Jakieda R Jackson/
Examiner, Art Unit 2626
April 16, 2008